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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,031	10/19/2000	Richard Baker Winslow	37631/DWR/S850	5435

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EXAMINER
PHAM, HUNG Q

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/692,031	WINSLOW, RICHARD BAKER
	Examiner	Art Unit	
	HUNG Q PHAM	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-23 and 49-53* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-23 and 49-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to the rejection of claims 11 and 18 under 35 U.S.C § 103 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment of claim 18 with respect to the rejection of claims 18-23 under 35 U.S.C § 112, first paragraph, has been fully considered. The rejection of claims 18-23 under 35 U.S.C § 112, first paragraph, has been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As in claim 49, the step of *authenticating the user using a cryptographic module remote*

from the terminal was not described in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 11 and 49 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

As in claim 11,

the clause *a validated address* in the step of printing a validated address on the VBI

references to at least two validating processes in order to return a validated address: (1)

address is validated based on the companion file, and (2) address is validated by

comparing with a database. It is unclear what validating process is being referenced to

return a validated address;

there is insufficient antecedent basis for *the address from a terminal remote from the*

database in the clause *if the address is not validated based on the companion file, receiving the*

address from a terminal remote from the database,

there is insufficient antecedent basis for *the validated address* in the clause *storing*

information relating to the validated address in the companion file upon a validation of the address,

and the validated address references to some other validated addresses. It is unclear

what validated address is being referenced.

Regarding claim 49, the clause *communicating with the terminal over a wide area*

network references to some other items, but it is unclear what item is being referenced.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 11, 12 and 14-17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pierce et al. [USP 5,930,796] in view of Jatkowski [USP

6,457,012 B1].

Regarding claim 11, Pierce teaches a method of validating an address for

printing on an envelope or label as value bearing item (VBI). The Pierce method

comprising:

accessing a companion file of pre-validated addresses for validating the address (as

illustrated at FIG. 2, Col. 3, Lines 58-62, mailing address of the envelope is checked

against address records as a companion file of pre-validated addresses);

printing the address on the VBI, if the address is validated based on the companion file (FIG.

2, steps 114→116→124);

printing a validated address on the VBI (FIG. 2, steps 114→116→124); and

storing information relating to the validated address in the companion file upon a validation of

the address (FIG. 3, postal code as information relating to the validated address at step

212 is stored in address record);

receiving the address from a terminal (Col. 3, Lines 60-64, and 19-22).

Pierce does not explicitly teach the steps of *storing a plurality of pre-approved*

addresses in a database remote from the terminal; if the address is not validated based on the

companion file, accessing the database; and *comparing the address from the remote terminal with the*

database of pre-approved addresses for validating the address.

Jatkowski teaches a method for updating address data representing of a

changed address. Jatkowski further discloses the step of *storing a plurality of pre-approved*

addresses in a database remote from the terminal (Jatkowski, FIG. 1, Col. 4, Lines 1-24,

database 28), *accessing the database;* and *comparing the address from the remote terminal with*

the database of pre-approved addresses for validating the address (Jatkowski, Col. 4, Line 30-Col.

5, Line 6).

Referring back to step 104 of FIG. 2 of Pierce, *if the address record is not validated*

based on the address record or *companion file,* instead of entering address into the local

database at step 108, Jatkowski method could be applied to Pierce method before

updating the database.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use a remote database for storing changed address, and accessing the remote database for comparing with an address does not match with address record as taught by Jatkowski in order to update a changed address for the local database.

Regarding claim 12, Pierce and Jatkowski, in combination, teach all of the claimed subject matter as discussed above with respect to claim 11, Pierce further discloses the step of *receiving the address comprises importing the address from a database of addresses* (Pierce, Col. 3, Lines 55-57).

Regarding claim 14, Pierce and Jatkowski, in combination, teach all of the claimed subject matter as discussed above with respect to claim 11, Pierce further discloses the step of *receiving a second address from the source; comparing selected information from the second address with stored information in the companion file; approving the address for use if the selected information corresponds with the stored information in the companion file; and accessing the database of valid addresses if no match is found* (Pierce, Col. 3, Line 58-Col. 4, Line 30).

Regarding claim 15, Pierce and Jatkowski, in combination, teach all of the claimed subject matter as discussed above with respect to claim 14, Pierce further discloses the step of *comparing the second address with the stored addresses in the companion file*

comprises determining whether a stored address in the companion file is stale, and rejecting the stored

address if it is stale (Col. 2, Lines 44-60).

Regarding to claims 16 and 17, Pierce and Jatkowski, in combination, teach all of

the claimed subject matter as discussed above with respect to claim 11, Jatkowski

further discloses *a remote database over a communication network*, which is *maintained by a*

remote address matching server (Jatkowski, FIG. 1).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Pierce et al. [USP 5,930,796] and Jatkowski [USP 6,457,012 B1] as applied to claim

12 above, and further in view of Hooper et al. [USP 5,819,282].

Regarding claim 13, Pierce and Jatkowski, in combination, teach all of the

claimed subject matter as discussed above with respect to claim 12, but fails to

disclose: *the address from the database of addresses is saved as comma-separated value (CSV) data,*

and further including: determining selected characteristics of the database of addresses; and

processing the CSV address data based on the characteristics of the database of addresses. Hooper

teaches a method for creating a database by storing a plurality of data objects in a

memory. Each data object has attributes including a key value and a data value. The

data objects are partitioned into a plurality of classes, each class having one or more

members, each member including the same attributes of the data objects. An access

method is defined for at least one member of a specific class to access the data objects

of the specific class by key values (Hooper, Abstract). Hooper further discloses the data

from the database is saved as comma-separated value (CSV) data, and further including: determining

selected characteristics of the database; and processing the CSV data based on the characteristics of

the database (Hooper, FIG. 5-6, Col. 4, line 11-Col. 7, line 47). Therefore, it would have

been obvious for one of ordinary skill in the art at the time the invention was made to

modify the Pierce method by using the technique as taught by Hooper for saving the

address data as CSV data, determining, and processing the CSV address in order to

have an easier, and faster way for manipulating data in an address database.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Jatkowski [USP 6,457,012 B1] in view of Pierce et al. [USP 5,930,796].

Regarding claim 18, Jatkowski teaches a method for matching an address with a

database of pre-approved addresses. The Jatkowski method comprising:

storing a plurality of pre-approved addresses with a predetermined format in the database;

receiving address data with different formats (FIG. 1, database 28, Col. 5, Lines 1-4, Col. 4,

Lines 50-54);

mapping the received address data with the different formats into a the predetermined format

(Col. 4, Lines 50-54);

comparing the address data in the predetermined format with pre-approved addresses in the

database for validating the address; presenting the results for selection by a user, if one or more

matches are found (Col. 4, Line 65-Col. 5, Line 19).

The missing of Jatkowski method is the step of *printing a selected address on the VBI.*

Pierce teaches a method of validating an address for printing on an envelope or

label as value bearing item (VBI). Pierce method comprising the step of *printing a selected*

address on the VBI (Pierce, FIG. 2, Col. 3, Line 58-Col. 4, Line 2).

Therefore, it would have been obvious for one of ordinary skill in the art at the

time the invention was made to include the step of printing a selected address as taught

by Pierce into the Jatkowski method in order to have an address in an envelope or a

label.

Regarding claim 19, Jatkowski and Pierce, in combination, teach all of the

claimed subject matter as discussed above with respect to claim 18, Jatkowski further

discloses the step of *accessing a remote database of addresses over a communication network*

(Jatkowski, FIG. 1, Col. 3, Line 50-Col. 4, Lines 16).

Regarding claim 20, Jatkowski and Pierce, in combination, teach all of the

claimed subject matter as discussed above with respect to claim 19, Jatkowski further

discloses *the database is maintained by a remote address matching server* (Jatkowski, FIG. 1,

Col. 3, Line 50-Col. 4, Lines 16).

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Jatkowski [USP 6,457,012 B1] and Pierce et al. [USP 5,930,796] as applied to

claim 18 above, and further in view of Wesinger, Jr. et al. [USP 6,324,538 B1] .

Regarding claim 21, Jatkowski and Pierce, in combination, teach all of the claimed subject matter as discussed above with respect to claim 18, but does not explicitly teach the step of *applying a plurality of query permuters to the address data to convert the data into respective formats*. Wesinger discloses the step of *applying a plurality of query permuters to the address data to convert the data into respective formats* (Wesinger, FIG. 2K). It would have been obvious for one of ordinary skill in the art at the time the invention was made to use query permuters as taught by Wesinger with Jatkowski and Pierce method in order to format the address data.

Regarding to 22, Jatkowski, Pierce and Wesinger, in combination, teach all of the claimed subject matter as discussed above with respect to claim 21, Wesinger further discloses the step of *applying at least one of a direct permuter and a single line permuter to the address data* (Wesinger, FIG. 2K).

Regarding claim 23, Jatkowski, Pierce and Wesinger, in combination, teach all of the claimed subject matter as discussed above with respect to claim 22, Wesinger further discloses the step of *applying a truncate permuter to the output structure of the direct permuter* (Wesinger, Col. 8, lines 37-52).

Claims 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jatkowski [USP 6,457,012 B1] in view of Pierce et al. [USP 5,930,796] and Lee et al. [USP 5,590,198].

Regarding claim 49, Jatkowski teaches a method for matching an address with a database of pre-approved addresses. The Jatkowski method comprising:

storing a plurality of pre-approved addresses in a database; receiving the address from a user using a terminal remote from the database (FIG. 1, database 28, Col. 5, Lines 1-4, Col. 4, Lines 50-54);

accessing the database from a server communicating with the terminal over the wide area network (FIG. 1, Col. 4, Line 65-Col. 5, Line 2);

comparing the address from the user with the database of pre-approved addresses for validating the address (Col. 4, Line 65-Col. 5, Line 19).

The missing of Jatkowski method is the step of *authenticating the user using a cryptographic module remote from the terminal*, and *printing a validated address on the VBI.*

Pierce teaches a method of validating an address for printing on an envelope or label as value bearing item (VBI). Pierce method comprising the step of *printing a validated address on the VBI* (Pierce, FIG. 2, Col. 3, Line 58-Col. 4, Line 2).

Lee teaches the step of *authenticating the user using a cryptographic module remote from the terminal* (Lee, FIG. 5 and 6).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include the step of authenticating as taught by Lee, and printing a selected address as taught by Pierce into the Pierce method in order to secure the data and have an address in an envelope or a label.

Regarding claim 50, Jatkowski, Pierce and Lee, in combination, teach all of the claimed subject matter as discussed above with respect to claim 49, Pierce further discloses the step of *storing information relating to the validated address in a the companion file upon a validation of the address* (Pierce, FIG. 2).

Regarding claim 51, Jatkowski, Pierce and Lee, in combination, teach all of the claimed subject matter as discussed above with respect to claim 49, Jatkowski further discloses the step of *importing the address from a database of addresses* (Jatkowski, Col. 5, Lines 7-19).

Regarding claim 52, Jatkowski, Pierce and Lee, in combination, teach all of the claimed subject matter as discussed above with respect to claim 49, Pierce further discloses the step of *receiving a second address from the user; comparing selected information from the second address with stored information in the companion file; approving the address for use if the selected information corresponds with the stored information in the companion file* (Pierce, FIG. 2). Jatkowski discloses the step of *accessing the database of valid addresses if no match is found* (Jatkowski, FIG. 2).

Regarding claim 53, Jatkowski, Pierce and Lee, in combination, teach all of the claimed subject matter as discussed above with respect to claim 52, Pierce further discloses the step of *determining whether a stored address in the companion file is stale, and rejecting the stored address if it is stale* (Pierce, Col. 4, Line 62-Col. 5, Line 19).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Hung Pham
March 1, 2005

SHAHID ALAM
PRIMARY EXAMINER